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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/729,927 | 12/09/2003 | Darrel Robert Slowski | DWE/SLOWSKI | 2425 |

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| EXAMINER | |
|---|---|
| HOGE, GARY CHAPMAN | |
| **ART UNIT** | **PAPER NUMBER** |
| 3611 | |

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/729,927 | SLOWSKI, DARREL ROBERT | |
| | Examiner | Art Unit | |
| | Gary C. Hoge | 3611 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 and 5-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 5-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 ends in two periods.

Claim 11 does not end in a period.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Arnold (3,680,238), Johnson (3,404,474), Matthews (4,272,901) and Weiss et al. (6,367,180).

Finnerty discloses a luminescent display for use in illuminating identification indicia, including a weatherproof housing (col. 1, lines 17-23) for attachment to a support surface; and a phosphorescent screen **25**. It is not known how large the screen is. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the screen in excess of twenty square inches because such a modification would have involved a

mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, Finnerty does not disclose a UV protective layer over the screen. Arnold teaches that it was known in the art to provide a display of the type disclosed by Finnerty with a layer that absorbs UV light. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display disclosed by Finnerty with a layer that absorbs UV light, as taught by Arnold, in order to protect the interior of the display from the damaging effects of exposure to UV light. Further, Finnerty does not disclose opaque indicia means. Rather, it is the background that is opaque. Johnson teaches that it is a known equivalent arrangement to use opaque indicia instead of an opaque background. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use opaque indicia in the device disclosed by Finnerty, as taught by Johnson, as an obvious matter of choice in design. Further, Finnerty does not disclose operating the screen at a voltage that is less than the rated voltage of the screen. Matthews teaches that it was known in the art to operate an illuminated display at less than its rated voltage, in order to "provide an expected life much greater than the normal life expectancy" (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the screen disclosed by Finnerty at less than its rated voltage, as taught by Matthews, in order to achieve a life expectancy that is much greater than the normal life expectancy. Further, Finnerty does not disclose a light sensor that disconnects the energizing means when the ambient light exceeds a predetermined threshold level. Weiss teaches that it was known in the art to use a light sensor to deactivate an illuminated display at dawn (col. 4, lines 23-26). It would have been obvious to one having ordinary skill in the art at the time the

invention was made to provide that device disclosed by Finnerty with a light sensor that turns the device off when the ambient light exceeds a predetermined threshold level, as taught by Weiss, in order to extend the life of the screen by not using it during daylight hours.

5. Claims 7, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Matthews (4,272,901) and Weiss et al. (6,367,180).

Finnerty discloses a house number identification panel having a plurality of number indicia in selected arrangement upon a viewing screen. It is not known from how far away the indicia are legible. However, that is a function of the size of the indicia, and it would have been obvious to one having ordinary skill in the art to make the indicia a suitable size to be legible from any desired distance, because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Finnerty further discloses a phosphorescent screen **25** and electrical supply means. However, Finnerty does not disclose operating the screen at a voltage that is less than the rated voltage of the screen. Matthews teaches that it was known in the art to operate an illuminated display at less than its rated voltage, in order to "provide an expected life much greater than the normal life expectancy" (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the screen disclosed by Finnerty at less than its rated voltage, as taught by Matthews, in order to achieve a life expectancy that is much greater than the normal life expectancy. Further, Finnerty does not disclose a light sensor that disconnects the energizing means when the ambient light exceeds a predetermined threshold level. Weiss teaches that it was known in the art to use a light sensor to deactivate an illuminated display at dawn (col. 4, lines

23-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide that device disclosed by Finnerty with a light sensor that turns the device off when the ambient light exceeds a predetermined threshold level, as taught by Weiss, in order to extend the life of the screen by not using it during daylight hours.

Regarding claim 8, it is not known how tall the indicia disclosed by Finnerty are. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them up to about four inches tall, because it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Matthews (4,272,901) and Weiss et al. (6,367,180), as applied to claim 8, above, and further in view of Johnson (3,404,474).

Finnerty discloses the invention substantially as claimed, as set forth above. However, Finnerty only discloses providing enough room for three numbers. Johnson teaches that it was known in the art to provide enough room on an illuminated display to accommodate four numbers. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the display disclosed by Finnerty wide enough to accommodate four numbers, as taught by Johnson, in order to make the display usable at addresses that have four numbers.

7. Claims 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Johnson (3,404,474) and Matthews (4,272,901).

Finnerty discloses a luminescent display for use in illuminating identification indicia, including a weatherproof housing (col. 1, lines 17-23) for attachment to a support surface; and a phosphorescent screen **25**. However, Finnerty does not disclose opaque indicia means. Rather, it is the background that is opaque. Johnson teaches that it is a known equivalent arrangement to use opaque indicia instead of an opaque background. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use opaque indicia in the device disclosed by Finnerty, as taught by Johnson, as an obvious matter of choice in design. Further, Finnerty does not disclose operating the screen at a voltage that is less than the rated voltage of the screen. Matthews teaches that it was known in the art to operate an illuminated display at less than its rated voltage, in order to "provide an expected life much greater than the normal life expectancy" (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to operate the screen disclosed by Finnerty at less than its rated voltage, as taught by Matthews, in order to achieve a life expectancy that is much greater than the normal life expectancy.

Regarding claim 14, It is not known how large the screen is. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the screen in excess of twenty square inches because such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, it is not known how tall the indicia disclosed by Finnerty are. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make them up to about four inches tall, because it has been held that discovering an optimum value of a result effective

variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finnerty (3,680,237) in view of Johnson (3,404,474) and Matthews (4,272,901), as applied to claim 11, above, and further in view of Weiss et al. (6,367,180).

Finnerty discloses the invention substantially as claimed, as set forth above. However, Finnerty does not disclose a light sensor that disconnects the energizing means when the ambient light exceeds a predetermined threshold level. Weiss teaches that it was known in the art to use a light sensor to deactivate an illuminated display at dawn (col. 4, lines 23-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide that device disclosed by Finnerty with a light sensor that turns the device off when the ambient light exceeds a predetermined threshold level, as taught by Weiss, in order to extend the life of the screen by not using it during daylight hours.

***Response to Arguments***

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary C Hoge
Primary Examiner
Art Unit 3611

gch